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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL WAYNE BROWN, KELVIN RODERICK
LAWRENCE, MICHAEL A. PAOLINI

Appeal 2009-008019
Application 09/560,392
Technology Center 3600

Decided: March 30, 2010

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 45-49, 51-55, and 57-59 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE and enter a new grounds of rejection under 35 U.S.C. 112, second paragraph.

THE INVENTION

The Appellants' claimed invention is directed an electronic consumer preference manager (Spec. 1:20-21). Claim 45, reproduced below, with some numerals in bracketing added, is representative of the subject matter of appeal.

45. A method for automatically electronically registering a user, said method comprising:

[1] generating a request to transmit a plurality of profile elements to a selected server system from among a plurality of server systems;

[2] transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems;

receiving a user profile comprising said plurality of profile elements in a particular transmittable data format at said selected server system from said portable computer system, wherein said selected server system is identified at said portable computer system utilizing data within said plurality of profile elements

specifying a consumer preference in response to a receipt of said request at said portable computer system, said user profile is associated with a particular user of said portable computer system, and each of said plurality of server systems is respectively associated with one of a plurality of consumer providers; and

registering said particular user with a consumer provider of said plurality of consume providers in response to a receipt of said user profile at said selected server system, wherein said consumer provider is associated with said selected server system.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Gardenswartz	US 6,055,573	Apr. 25, 2000
Madison	US 2002/0023123 A1	Feb. 21, 2002
Klug	US 6,823,327 B1	Nov. 23, 2004

The following rejections are before us for review:

1. Claims 45-49, 51-55, and 57-59 are rejected under 35 U.S.C. § 103(a) as unpatentable over Klug, Gardenswartz, and Madison.

THE ISSUES

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether Klug, Gardenswartz, and Madison disclose claim limitation [2] identified above and if the combination of references would have been obvious.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:¹

FF1. Klug discloses a World Wide Web registration system to assist users in registering at web sites. A repository is provided so the users registration information can be transferred to a plurality of web sites (Abstract).

FF2. Klug at Fig. 3 discloses a flowchart for describing the steps a user performs in entering web site registration information into fill-out forms (Col.3:22-26). Fig. 3 at item 308 discloses that basic information fill out forms are presented to the user including fields for: name, e-mail address, gender, and date of birth. Klug at Fig. 4A and 4B discloses that a third party web site 116 can access a users registration data 436 from a registrar web site.

FF3. Klug at Col. 1:45-56 discloses that some web sites require a “user to register” at the website, and provide personal information such as the city of residence or family size.

FF4. Madison discloses a geographic data locator (Title). A database is queried to obtain geographic data and transmit localized information to a host system based on the geographic data. A geographic cookie file may be used transmit localized data to a specified geographic location (Abstract).

FF5. Madison at [0032] discloses in step 310 that location information is written into the browser geographic cookie file or directory on the client computer. In step 312 the geographic information is supplied to the website server which can use the information to target advertising.

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF6. Madison at [0005] discloses that it may also be desirable to prevent users in a specific geographic region from accessing certain data. For example it may be desirable to “black out” a broadcast of a sporting event for users in a home team’s geographic area.

FF7. Gardenwartz discloses a computer program product for delivering targeted advertisement (Abstract).

FF8. Webster’s New World Dictionary, Third College Edition, 1988, defines “proximity” as: the state or quality of being near; nearness in space, time, etc.

FF9. Webster’s New World Dictionary, Third College Edition, 1988, defines the first two definitions of “location” as: 1. a locating or being located 2. position in space; place where a factory, house, etc. is or is to be; situation.

FF10. The Specification at Fig. 5, steps 156 and 160 does not disclose an algorithm “for transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems”.

PRINCIPLES OF LAW

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying

factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 U.S. at 415, (citing *Graham*, 383 U.S. at 12), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

The Appellants argue that the rejection of claims 45 is improper because the prior art fails to disclose claim [2] as identified above (Br. 9-10).

In contrast the Examiner has determined that the cited claim limitation [2] is disclosed by Klug at Fig. 3 (item 308); Klug at Col. 1:45-56; and Madison [0032] (Ans. 11 and 16-17).

We agree with the Appellants. Claim 45 includes limitation [2] which requires:

[2] “transmitting said request to a portable computer system in response to a determination that said portable computer system *is within a particular proximity* to said plurality of server systems”.

Madison discloses that a geographic cookie file may be used transmit localized data to a *specified geographic location* (FF4). Madison at [32] discloses that location information is written into the browser geographic cookie file and that the geographic information is supplied to the website server which can use the information to target advertising (FF5). Thus, Madison at [0032] discloses transmitting to a computer data based on a determination that it is in a *specified geographic location* and it is not disclosed that it is “*within a particular proximity*” as claimed. Klug at Fig. 3 (item 308) discloses that an e-mail address (FF3) is used and at Col. 1:45-56 describes that city of residence is given (FF4). Neither of these two

citations to Klug discloses transmission of data based on a determination for being “*within a particular proximity*” as claimed. Note that while Klug in Col. 1:45-56 discloses that a city of residence is used this is a specific *location* and not a “*within a particular proximity*” as claimed.

Further, Klug which is directed to a World Wide Web registration system to assist users in registering at web sites (FF1). In Klug, the users registration information can be transferred to a plurality of web sites (FF2) and the rejection fails to provide articulated reasoning with rational underpinnings to support the legal conclusion of obviousness since it is unclear that the registration information would be restricted on the basis of a being within a particular proximity of a specific location. Klug is directed to registration information, not advertising information, and it is unclear why such a combination would desire to restrict the registration information based on a particular proximity. For these reasons the rejection of claims 45 and its dependent claims is not sustained. The rejection of claims 51, 57, and their dependent claims is not sustained for these same reasons as they also contain a limitation similar to [2].

NEW GROUNDS OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 51-55 and 57-59 under 35 U.S.C. § 112, second paragraph as being indefinite

Principles of Law

Means-plus-function claim language must be construed in accordance with 35 U.S.C. § 112, paragraph 6, by “look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material,

or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

When no structure is described in the Specification to support a means-plus-function limitation in a claim, the disclosure is inadequate to explain to one of ordinary skill in the art what is meant by the claim language. In such a situation, a means-plus-function claim would not be amenable to construction and thus would fail to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

"[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed.Cir.1994) (en banc). This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing § 112, ¶ 6. *See O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1583 (Fed. Cir. 1997). "Fulfillment of the § 112, ¶ 6 trade-off cannot be satisfied when there is a total omission of structure." *Atmel*, 198 F.3d at 1382. While corresponding structure need not include all things necessary to enable the claimed invention to work, it must include all structure that actually performs the recited function. *See Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1119 (Fed.Cir.2002).

Default Proof Credit Card Sys. v. Home Depot U.S.A., Inc., 412 F.3d 1291, 1298 (Fed. Cir. 2005).

When the means-plus-function limitation in a claim is a *computer-enabled* means-plus-function limitation, one must set forth in the specification sufficient description of an *algorithm* associated with the

function recited in the claim in order to avoid a finding that an applicant has failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

It is certainly true that the sufficiency of the disclosure of algorithmic structure must be judged in light of what one of ordinary skill in the art would understand the disclosure to impart. *See, e.g., Intel Corp. v. VIA Techs.*, 319 F.3d 1357, 1367 (Fed. Cir. 2003) (knowledge of a person of ordinary skill in the art can be used to make clear how to implement a disclosed algorithm); *Atmel Corp.*, 198 F.3d at 1379 (“[T]he ‘one skilled in the art’ analysis should apply in determining whether sufficient structure has been disclosed to support a means-plus-function limitation.”). That principle, however, has no application here, because in this case there was no algorithm at all disclosed in the specification. The question thus is not whether the algorithm that was disclosed was described with sufficient specificity, but whether an algorithm was disclosed at all.

Aristocrat Techs. Australia Party, Ltd. vs. Int’l Game Tech., 521 F.3d 1328, 1337 (Fed. Cir. 2008).

When there is insufficient description of an algorithm in the Specification to support a computer-enabled means-plus-function limitation in a claim, the disclosure will be considered inadequate to explain to one of ordinary skill in the art what is meant by the claim language.

For computer-implemented means-plus-function claims where the disclosed structure is a computer programmed to implement an algorithm, “the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999). Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶ 6. This court permits a patentee to express that algorithm in any understandable terms

including as a mathematical formula, in prose, *see In re Freeman*, 573 F.2d 1237, 1245-46 (CCPA 1978), or as a flow chart, or in any other manner that provides sufficient structure. The district court correctly determined that the structure recited in the '505 specification does not even meet the minimal disclosure necessary to make the claims definite. Simply reciting “software” without providing some detail about the means to accomplish the function is not enough. *See Aristocrat Techs. Austl. Pty v. Int'l Game Tech.*, 521 F.3d 1328, (Fed.Cir.2008) (“For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the function, as required by section 112 paragraph 6.”). This court does not impose a lofty standard in its indefiniteness cases. *See, e.g., Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1214 (Fed.Cir.2003). But in this case, the claims are already quite vague. Without any corresponding structure, one of skill simply cannot perceive the bounds of the invention.

Finisar Corp. v. DirecTV Group, Inc., 523 F.3d 1323, 1340-41 (Fed. Cir. 2008).

When a Specification discloses *no* algorithm corresponding to a computer-enabled means-plus-function limitation in a claim, an applicant has necessarily failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. *See also Aristocrat*, 521 F.3d 1328, 1333 (*quoting Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1253 (Fed. Cir. 2005) (“[t]he corresponding structure for a § 112 ¶ 6 claim for a computer-implemented function is the algorithm disclosed in

the specification.’ *Harris* 417 F.3d at 1249.”); *Net MoneyIN, Inc. v. Verisign, Inc.* 545 F.3d 1359, 1367 (Fed. Cir. 2008) (“[A] means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function.”). *See also Blackboard, Inc. v. Desire2Learn Inc.*, 574 F.3d 1371 (Fed. Cir. 2009) (finding Blackboard’s means-plus-function claims indefinite because the patent describes an undefined component, *i.e.*, a black box, that performs the recited function but does not disclose how the component performs the function). *See further Ex parte Catlin*, 90 USPQ2d 1603, 1605 (BPAI 2009) (precedential) (during prosecution, computer-enabled means-plus-function claims will be held unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite if a Specification fails to disclose any algorithm corresponding to the recited function in the claims).

Analysis

We reject claims 51-55 and 57-59 under 35 U.S.C. § 112, second paragraph, as being indefinite.

We count 4 limitations in claim 51 which are in means-plus-function format. We will focus on the “means for transmitting” limitation. But the analysis to follow applies equally as well to the other means-plus-function limitations in claim 51 and 57.

The limitation “means for communicating” includes the term “means.” A claim limitation that includes the term “means” is presumed to be intended to invoke means-plus-function treatment, *i.e.*, treatment under 35 U.S.C. §112, 6th paragraph. *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d

1294, 1302 (Fed. Cir. 1999) (“presumed an applicant advisedly used the word “means” to invoke the statutory mandates for means-plus-function clauses.”). Construing means-plus-function claim language in accordance with 35 U.S.C. § 112, paragraph 6, is a two step process.

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed.Cir.2001). “The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed.Cir.2002). Thus, according to the language of claim 11, the function of the “horizontal drive means” is “rotating said lamp unit in a horizontal direction.” Ordinary principles of claim construction govern interpretation of this claim language, *see id.*, and, for all the reasons discussed in the preceding two sections, we construe this function according to its ordinary meaning as not requiring rotation through 360°.

The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. “Under this second step, ‘structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.’” *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed.Cir.2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed.Cir.1997)).

Golight Inc. v. Wal-Mart Stores Inc., 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

Step 1- The first step in construing a means-plus-function claim limitation is to define the particular function in the means-plus-function limitation.

The particular function of the means-plus-function claim limitation at issue is “for transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems”.

Further, given the claim as a whole being directed to a “system for electronically registering a user” which we have construed as reasonably broadly involving a computer, one of ordinary skill in the art would construe the claim limitation “means for transmitting” to refer to a *computer-enabled* means-plus-function limitation.

Step 2- The next step in construing a means-plus-function claim limitation is to look to the Specification and identify the corresponding structure for that function. Given that the claim limitation “means for transmitting” is a *computer-enabled* means-plus-function limitation, this requires looking to the Specification and identifying the algorithm corresponding to the function of “for transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular proximity to said plurality of server systems”.

In that regard, we note that in the Summary of Claimed Subject Matter (App. Br. 5), the Appellants have attempted to show where in the Specification, by page and line number, there is disclosed structure, material, or acts corresponding to each claimed function as required by 37 C.F.R. § 41.37(c)(1)(v) (2007). With regard to the claim 51 means-plus-function limitation at issue, the Appellants attempt to show that the disclosed structure is shown at Fig. 5 steps 156 and 160. We find no algorithm to disclose “transmitting said request to a portable computer system in response to a determination that said portable computer system is within a particular

proximity to said plurality of server systems” at Fig. 5 steps 156 and 160 (FF10).

The Specification therefore fails to disclose an algorithm corresponding to the recited function at issue (FF10) in claim 51 such that one of ordinary skill in the art could determine the scope of claim 51. Accordingly, we reject claims 51-55 and 57-59 under 35 U.S.C. § 112, second paragraph, as being indefinite.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 45-49, 51-55, and 57-59 under 35 U.S.C. § 103(a) as unpatentable over Klug, Gardenswartz, and Klug.

DECISION

The Examiner’s rejection of claims 45-49, 51-55, and 57-59 is reversed.

We also enter a new ground of rejection of claims 51-55 and 57-59 under 35 U.S.C. § 112, second paragraph.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

MP

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